

REMARKS**Status of Claims**

Prior to this Amendment:

Claims 1-19 are pending. Claims 20-21 are cancelled.

Upon entry of this Amendment:

Claims 1-9 and 11-19 are pending. Claims 10, 20 and 21 are cancelled. Claim 22 has been added. Claims 1-7 and 11-14 have been amended.

Amendments to Claims

Claims 1-7 and 11-14 have been amended. Support for these amendments can be found, *inter alia*, in the claims as originally filed, page 8, lines 7-12 of the specification as originally filed, and at page 17, lines 24-26 of the specification as originally filed.

Support for Claim 22 can be found, *inter alia*, in originally filed Claim 7.

Priority

Acknowledgment is made by the Office of Applicant's claim for foreign priority based on an application filed in Canada on February 6, 2004. It is noted by the Office however, that Applicant has not filed a certified copy of the CA 2,457,214 application as required by 35 U.S.C. § 119(b). The Office notes that a certified copy of CA 2,470,403, with a priority date of June 9, 2004, has been filed in the Application.

Applicant thanks the Office for pointing out this deficiency. Applicant will submit a certified copy of the CA 2,457,214 application under separate copy.

Information Disclosure Statement

The Office states on page three of the OA that the Information Disclosure Statement (IDS), filed on October 25, 2006, fails to comply with 37 CFR § 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. The Office states that the IDS has been placed in the application file, but the information referred to therein has not been considered.

Applicant herein submits a Supplemental IDS, which includes “crossed-out” documents 14-20 that were listed on the Alternative to PTO/SB/08a/b form that was attached to the OA.

Applicant would appreciate the Office reviewing the documents listed on the Alternative to PTO/SB/08a/b form and entering the Supplemental IDS and accompanying documents into the record.

Rejection of Claims 1-7, 14, 15, 18 and 19 Under 35 USC § 102 (a)

The Office states on pages three and four of the OA that Claims 1-7, 14, 15, 18 and 19 are rejected under 35 U.S.C. § 102(a) as allegedly being anticipated by Candela Corporation WO 2003/086460 A2 (herein “Candela”).

The legal standard for anticipation under 35 U.S.C. §102 is one of strict identity. To anticipate a claim, a single prior source must contain each and every limitation of the claimed invention. In re Paulson, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994) (citing In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990)). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). MPEP §2131; pg 2100-76, 8th ed., Rev. 3, August 2005.

In Candela, the examples and references to the treatment of hyperactive sebaceous gland disorders discuss the use of 5-aminolevulinic acid (ALA) as the photosensitizer. In addition, the only example featuring verteporfin is limited to the treatment of nevoid basal cell carcinoma syndrome. Therefore, Candela is *not* a single prior source that contains each and every limitation of the amended claim 1. All other rejected claims are dependent from Claim 1.

For the reasons set forth above, Applicant respectfully requests that the rejection of Claims 1-7, 14, 15, 18 and 19 are rejected under 35 U.S.C. § 102(a) be withdrawn.

Rejection of Claims 8-13 and 16-17 Under 35 USC § 103(a)

The Office rejects Claims 8-13 and 16-17 under 35 U.S.C. § 103(a) as being unpatentable over Candela, as applied to claims 1-7, 14, 15, 18 and 19 as described above, and further in view of Olive Oil Chemistry (U) Bershad U.S. Patent No. 6,096,765 (herein “Olive”). The Office’s arguments are set forth on pages five to eight of the OA.

The Office cites Candela for teaching, *inter alia*, “a method of treating acne, oily skin and sebaceous hyperplasia ... comprising topical application [] of photosensitizers in the skin region affected by the conditions....”

The Office states on page seven of the OA that Candela is defective in that it “does not teach a specific viscosity [of the composition]”

However, Applicant respectfully avers that Candela is further defective in that it does not teach, *inter alia*, a “method to treat hyperactive sebaceous gland disorders, other than acne, in a subject by (i) topically applying a hydrophobic and/or lipophilic photosensitizer composition to skin tissue exhibiting symptoms of a hyperactive sebaceous gland disorder, and (ii) exposing the tissue of said subject to light energy at a wavelength capable of activating the photosensitizer and at a fluence rate between about 0.1 mW/cm² and about 600mW/cm², wherein said photosensitizer is other than 5-aminolevulinic acid and derivatives thereof.”

Olive is cited for, *inter alia*, teaching the viscosity of olive oil.

However, Applicant respectfully submits that Olive does not teach or suggest a “method to treat hyperactive sebaceous gland disorders, other than acne, in a subject by (i) topically applying a hydrophobic and/or lipophilic photosensitizer composition to skin tissue exhibiting symptoms of a hyperactive sebaceous gland disorder, and (ii) exposing the tissue of said subject to light energy at a wavelength capable of activating the photosensitizer and at a fluence rate between about 0.1 mW/cm² and about 600mW/cm², wherein said photosensitizer is other than 5-aminolevulinic acid and derivatives thereof.” Accordingly, Olive cannot cure the defects in Candela.

In addition, neither Candela or Olive provide support for a reasonable expectation of success in practicing the method of amended Claim 1. Furthermore, salicylic acid in the Candela document is not an equivalent to the topical retinoids of Olive, as stated by the Office on page eight of the OA, because the former is only used for descaling and does not constitute an acne treatment in and of itself, as do the topical retinoids of Olive.

Thus, because the combination of Candela and Olive do not teach the (amended) claimed invention a *prima facie* case of obviousness has not been made and the rejection of Claims 8-13 and 16-17 under 35 U.S.C. § 103(a) be withdrawn.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 249692001700. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: May 5, 2009

Respectfully submitted,

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